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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ART UNIT	PAPER NUMBER
3773	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/784,401	BONUTTI, PETER M.	
	Examiner	Art Unit	
	Melanie Tyson	3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 August 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,16-19,24 and 26-50* is/are pending in the application.

4a) Of the above claim(s) *16-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,19,24, and 26-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the applicant's amendment received on 26 August 2008. Claims 8-15, 20-23, and 25 are cancelled. New claims 44-50 have been added. Claims 16-18 remain withdrawn from consideration.

Response to Arguments

Applicant's arguments with respect to claims 1-7, 19, 24, and 26-50 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claims 1 and 40 are objected to because of the following informalities: typographical errors. Insert --one of-- between the phrases "a magnetic field generator disposed in" and "said tissue engaging" and replace "surface" with --surfaces--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 6, 24, and 44-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A single claim which claims both an apparatus and the method steps of using the apparatus ("is varied"; "is positioned"; "is altered") is indefinite under 35 U.S.C. 112, second paragraph. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4, 6, 24, and 44-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101, which is drafted so as to set forth the statutory classes of invention in the alternative only. See MPEP 2173.05(p).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26-29, **31, and 45** are rejected under 35 U.S.C. 102(b) as being anticipated by **Armao (U.S. Patent No. 3,391,690)**.Armao discloses a device (see entire document) comprising a body (10 and 11), a carrier (the jaws), a tip (tips of jaws), and a magnetic element (25 or 26) attached to the body, thus is part of the body, wherein the magnetic element is permanent in that it is not removed from the device during use, the magnetic element is movable with movement of the body (i.e., towards and away from each other), and the field may be considered to be altered or

activated/deactivated through forced movement of the handles. The introductory statement of intended use and other functional language has been carefully considered, but deemed not to impose any structural limitations on the claims to make them patentably distinguishable over Armao's device, which is capable of being used as claimed if one desires to do so.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Armao**. Armao discloses the claimed invention except for an electromagnet magnetic element. However, the applicant has failed to disclose that such a magnet provides an advantage, is used for a particular purpose, or solves a stated problem and it appears Armao's magnets would perform equally well. Therefore, it would have been obvious to

one having ordinary skill in the art at the time the invention was made as a matter of design choice to modify Armao's device with well known electromagnets.

Claims 1-7, 19, 24, 32-44, and 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Armao in view of Francischelli (U.S. Patent No. 6,699,240 B2)**. Armao discloses an apparatus (see entire document) comprising a first handle (10), a second handle (11), a pivot (12) connecting the handles, first and second tissue engaging surfaces (surfaces on the jaws), a magnetizable material (magnet 25 or 26), and a magnetic field generator (25 or 26; whichever is not considered the magnetic material), wherein the magnetizable material is permanent in that it is not removed from the device during use, the generator is selectably positionable at the position selected (see Figures), the polarity may be reversed such that the magnetizable material and generator can either retract or repel (depending on polarity; for example, see column 4, lines 34-36), and the field may be considered to be altered or activated/deactivated through forced movement of the handles. It is noted that the handles may bias or spread the tissue engaging surfaces or bias and compress the tissue engaging surfaces. The introductory statement of intended use and other functional language has been carefully considered, but deemed not to impose any structural limitations on the claims to make them patentably distinguishable over Armao's device, which is capable of being used as claimed if one desires to do so. Armao fails to disclose the magnetizable material and magnetic field generator are disposed in the tissue engaging surfaces.

Francischelli discloses an apparatus (see entire document) comprising first and second handles (see Figure 1) and tissue engaging surfaces (20 and 22). Francischelli teaches providing magnetizable material and magnetic field generators in the tissue engaging surfaces (for example, see Figure 2A), wherein either/or both may comprise electromagnets (for example, see column 13-15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to place Armao's magnetizable material and magnetic field generator in the tissue engaging surfaces as taught by Francischelli. Doing so would enhance clamping of the tissue engaging surfaces on tissue (for example, see column 4, lines 22-25).

Regarding claim 38, Armao and Francischelli fail to disclose or suggest the magnetizable material includes iron. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the magnetizable material of iron, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Friday 7-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./
Examiner, Art Unit 3773
February 13, 2009

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773